

REMARKS

While applicant disagrees with the restriction requirement set forth in the Office Action. Applicant provisionally elects with traverse Invention I (claims 1-18) for examination.

ARGUMENTS

The Examiner asserted that Inventions II and I are related as combination and subcombination. In particular, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the interface mechanism. Applicant does not understand the reasoning, since the combination claimed in claim 19 does require the interface mechanism, and in fact the specific interface mechanism recited in claim 1. The Examiner is directed to the comparison of claims 1 and 19 below.

Claim 1 recites:

"An interface mechanism for interfacing at least an associated component of a capillary cartridge to at least an external component that makes available a support element required by a bio-analytical process for a bio-sample, comprising:

a support structure supporting the cartridge in relation to the external component;
at least one biasing device supported by the support structure, the biasing device supporting and biasing the external component against the associated component of the capillary cartridge, thereby making the support element available to the cartridge to conduct the bio-analytical process."

Claim 19 recites:

"A bio-analytical system for conducting a bio-analytical process for a bio-sample in a capillary cartridge, comprising:

a support for a sample;

an interface mechanism for interfacing the capillary cartridge to a support element

required by the bio-analytical process, comprising:

at least an external component that makes available the support element

required by the bio-analytical process:

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Applicant respectfully submits that the Examiner referenced a utility of the subcombination that is beyond the scope of the relevant subject matter recited in the subcombination. In fact, the interface mechanism as disclosed, absent modifications beyond the scope of such disclosure, would not be useful as a head for connecting pins for spotting DNA to an array. Applicant respectfully requests the Examiner to teach how such utility may be accomplished. MPEP 806.05(e) provides "[i]f applicant proves or provides an argument, supported by facts, that the utility suggested by the examiner cannot be accomplished, the burden shifts to the examiner to document a viable separate utility or withdraw the requirement."

Further, Applicant notes that MPEP 806.05(c) does not require using unbounded imagination and speculations to seek hypothetical utility of the subcombination. Applicant respectfully submits that the scope of inquiry to determine alternate utility of the subcombination should reasonably be limited to those utility that may reasonably be undertaken by the claimed subcombination. Otherwise, applying the Examiner's reasoning, one could have used the subcombination to carry out many other utilities, such as sealing tin cans. According to MPEP 806.05(c), "[t]he burden is on the examiner to suggest an example of separate utility." Here, the Examiner has not met his burden.

Both requirements under MPEP 806.05(c) must be satisfied to support a restriction (i.e., MPEP 806.05(c) provides: "The inventions are distinct if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. When these factors cannot be shown, such inventions are not distinct." Accordingly, even if the subcombination can be shown

to have a different utility, given that the first condition under MPEP 806.05(c) has not been met, the restriction requirement should be withdrawn.

Should the Examiner maintain the restriction, Applicant reserves the right to file a divisional application on the non-elected Invention II (claims 19-20) at a later date.

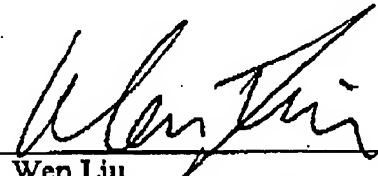
CONCLUSION

The Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this transmittal and associated documents, or to credit any overpayment to Deposit Account No. 501288 referencing the attorney docket number of this application.

Respectfully submitted,

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